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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,032	07/10/2001	Noriyuki Jinbo	032567-017	6369
7590 03/09/2005			EXAMINER	
Platon N. Mandros BURNS, DOANE, SWECKER & MATHIS, L.L.P. P.O. Box 1404 Alexandria, VA 22313-1404			SINGH, SATWANT K	
			ART UNIT	PAPER NUMBER
			2626	
DATE MAILED: 03/09/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/901,032	Applicant(s) JINBO ET AL.	
	Examiner Satwant K. Singh	Art Unit 2626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2001.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 8-13, 16-21 and 24-26 is/are allowed.
- 6) ☒ Claim(s) 7, 14, 15, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 14, 15, 22, and 23 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The above mentioned claims cite "an external device" which is critical or essential to the practice of the invention, but not included in the specification and is not enabled by the disclosure (Fig. 4, paragraphs [0054] and [0055]). See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 15 recites the limitation "external device" in claim 7. There is insufficient antecedent basis for this limitation in the claim. It appears to the examiner that claim 15 should reference claim 14. Appropriate correction is required.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7 and 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/040,380. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter as follows:

Regarding Claim 7, an image forming apparatus, comprising a printer (image forming device) which prints a print job on paper; a communication device which communicates wireless with a prescribed portable terminal when there is a print job waiting for being printed by said printer (wireless communication unit capable of wirelessly communicating with said portable terminals); a position detector of said portable terminal based on a communication result of said communication device (identifying unit); and a mode selector which select one mode from a plurality of modes concerning power consumption of said printer based on said position of said portable terminal detected by said position detector (power saving control unit).

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Regarding Claim 15, an image forming apparatus, further comprising a terminal selector which selects a portable terminal according to said external device (identifying unit for identifying a portable unit closest to the image forming device).

Therefore, it would be obvious to one having ordinary skill in the art that these limitations are variations of each other.

***Allowable Subject Matter***

6. Claims 1-6, 8-13, 16-21, 24-26 are allowed.

7. Regarding Claim 1, prior art teaches an image forming system, comprising: an image forming apparatus with a plurality of modes concerning power consumption, said image forming apparatus being capable of wirelessly transmitting information that there is a waiting job; a portable terminal which is capable of receiving said information transmitted wirelessly from said image forming apparatus.

Prior art fails to teach an image forming system comprising: position detector which detects a position of said portable terminal; and a mode switcher which switches from one mode concerning power consumption of said image forming apparatus to another in accordance with said position of said portable terminal which received said information.

8. Regarding Claim 2, prior art teaches an image forming apparatus, comprising: transmitter which is capable of wirelessly transmitting job-existence-information that there is an output-waiting-job to a portable terminal; a receiver which receives reply-

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information replying to said job-existence-information transmitted wirelessly from said portable terminal.

Prior art fails to teach an image forming apparatus, comprising: a position detector which detects a position of said portable terminal whose reply-information is received by said receiver; and a mode switcher which switches from one mode concerning power consumption to another based on said position of said portable terminal detected by said position detector.

9. Regarding Claim 17, prior art teaches an image forming apparatus, comprising: a job-output device which outputs a job; a communication device which communicates wirelessly with a prescribed portable terminal when there is an output-waiting-job waiting to be outputted from said job-output device.

Prior art fails to teach an image forming apparatus, comprising: a position detector which detects a position of said portable terminal based on a communication result of said communication device; and a controller which controls said image forming apparatus based on said position of said portable terminal detected by said position detector.

10. Regarding Claim 25, prior art teaches an image forming apparatus, comprising: a printing device which prints a print job on a paper; a communication device which communicates wirelessly with a prescribed portable terminal when there is a print job waiting for being printed by said printing device.

Prior art fails to teach an image forming apparatus, comprising: a position detecting device which detects a position of said portable terminal based on a

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communication result of said communication device; and a controller which selects one mode from a plurality of modes concerning power consumption of said printing device based on said position of said portable terminal detected by said position detecting device.

11. Regarding Claim 26, prior art teaches an image forming apparatus, comprising: an output device which outputs a job; a communication device which communicates wirelessly with a prescribed portable terminal when there is an output-waiting-job waiting for being outputted from said output device.

Prior art fails to teach an image forming apparatus, comprising: a position detection device which detects a position of said portable terminal based on a communication result of said communication device; and a controller which controls said image forming apparatus based on said position of said portable terminal detected by said position detection device.

12. Claims 7 and 15 would be allowable if rewritten or amended to overcome the rejection(s) under double patenting, set forth in this Office action.

13. Claims 14, 15, 22, and 23 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Struble (US 6,745,253) discloses a system and method for locating and using a peripheral device.

Idehara (US 2002/0089694) discloses an image forming system and device and control method and control program for controlling image forming device.

Kondou et al (US 2004/0248569) discloses a portable terminal having function of detecting another person's approach utilizing short distance wireless communication means, and storage medium and server that are used for the detection.

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (703) 306-3430. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



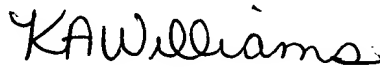
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



sks

Satwant K. Singh  
Examiner  
Art Unit 2626



**KIMBERLY WILLIAMS**  
**SUPERVISORY PATENT EXAMINER**